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| APPLICATION NO | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO | CONFIRMATION NO. |
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| 09/991,474 | 11/21/2001 | Michael Safdeye | 0851/111 18-US1 | 4563 |

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| EXAMINER | |
|---|---|
| LEE, EDMUND H | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1732 | |

DATE MAILED: 02/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/991,474 | SAFDEYE ET AL. | |
| | Examiner | Art Unit | |
| | EDMUND H. LEE | 1732 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *8-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

## DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-7, drawn to the method of molding a insert into another material and forming a sole, classified in class 264, subclass 510.

   II. Claims 8-13, drawn to the method of making and ordering a shoe through a distributed computer network, classified in class 705, subclass unknown.

   III. Claim 14-20, drawn to a shoe kit, classified in class 36, subclass 59R.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product made can be made by punching or cutting out the ousole from stock material and attaching the sole to the upper.

3. Inventions II and (I and III) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation function and effect. Invention II is a business method claim involving computer entry and ordering whereas the other two inventions are a product (kit claim) and a method of making a product involving molding of an outsole.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, have acquired a separate status in the art because of their recognized divergent subject matter and the search required for any one Group is not required for any of the other Groups, restriction for examination purposes as indicated is proper.

5. During a telephone conversation between Examiner Stashick and Edward Ellis on March 11, 2003 a provisional election was made without traverse to prosecute the invention of Invention I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-20 are hereby withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the ELECTED invention to which the claims are directed.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2-283303 A in view of Walters (USPN 384483). In regard to claim 1, JP 2-283303 A teaches a method of making a shoe (abstract; figs 1-3); providing a shoe upper (abstract; figs 1-3); attaching an outsole having a ground contacting surface to the shoe upper (abstract; figs 1-3); inserting a section of non-slip material into a mold (abstract; pg 4, ln 10; figs 1-3); and injecting a first material into the mold and operating the first mold to form the outsole, wherein the outsole includes a first section formed of the first material and a second section formed of the non-slip material, the second section being exposed to the ground contracting surface of the outsole and the first section is free of any fabric material (abstract; figs 1-3). However, JP 2-283303 A does not teach using a fabric material. Walters teaches a shoe having a fabric outsole wherein the fabric provides non-slip characteristics (pg 1, lns 9-10 and 19-25). JP 2-283303 A and Walters are combinable because they are analogous with respect to shoes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use fabric as taught by Walters as the non-slip material of JP 2-283303 A in order to enhance aesthetic appeal while maintaining functionality. In regard to claims 2-7, JP 2-283303 A teaches using the claimed mold design of claim 4 (figs 1-3); using thermoplastic rubber (pg 5, ln 8); and using the mold design of claim 7 (figs 1-3). However, JP 2-283303 A does not teach using a nonwoven fabric; molding the second section to meet the limitations of claim 5; and using a mold that is either in a hot state or a cold state prior to injecting the first material. In regard to using a nonwoven fabric,

such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, it is well-known in the shoe art to use nonwoven fabric. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use nonwoven fabric as the insert of JP 2-283303 A in order to enhance aesthetic diversity of the shoe. In regard to molding the second section to meet the limitations of claim 5, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, shoes having the claimed classification are well-known in the shoe art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mold the second section to be classified as claimed in order to diversify the shoe. In regard to using a mold that is either in a hot state or a cold state prior to injecting the first material, it is well-known in the molding art to use a mold in a hot state or a cold state. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the mold of JP 2-283303 A in either a hot or cold state in order to reduce cycle time or prevent damage to the insert of JP 2-283303 A.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references teach a non-woven outsole: Hiraoka et al (USPN 6255235); Mitchell (USPN 1716790); JP 2000-23707; and Bleimhofer (USPN 5505011).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571.272.1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDMUND H. LEE
Primary Examiner
Art Unit 1732

EHL

2/9/04